

REMARKS

Applicants have thoroughly considered the Examiner's remarks and the application has been amended in light thereof. Claims 1-13, 15-31, 45, and 48-52, and 57 are presented in the application for further examination. Claim 58 has been canceled by this Amendment C so that the 35 USC 112 rejection should be withdrawn.

Reconsideration of the application claims as amended and in view of the following remarks is respectfully requested. The following remarks will follow the sequence of the Office action.

Claims 1-3, 6-8, 10-11, 15, 17-21, 23-27, 30, 31, 45, 48-52 and 57 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Unger et al. (US 6,093,027) in view of Hartman et al. (US 5,960,411). Unger teaches placing a single order for disposable absorbent articles used by women for catamenial protection. (Unger, column 4, lines 16-18) Hartman teaches that items may be ordered from a web site with a single action. (Hartman column 3, line 31-33) Hartman also discloses that a consumer may continue shopping after verifying order items. (Hartman, Fig. 1C). The Examiner admits that Unger falls short and "does not teach prompting the consumer to place another purchase order for the products" and points to the "Continue Shopping" feature of Hartman.

In the Response To Arguments on pages 15-16 of the Office action, the Examiner incorrectly concludes that the determined assortment is nonfunctional:

"Furthermore the limitation '... for products corresponding to the determined assortment of feminine care products' appears to be nonfunctional descriptive material. The steps of determining, accepting, and prompting would be performed the same regardless of the type of product. Thus this nonfunctional descriptive material will not distinguish the claimed invention

from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106."

The limitation of a **determined assortment** is a functional recitation defining a functional relationship. Therefore, this limitation must be considered. Claim 1 recites three different steps, the function of which is directly related to and dependent upon the **determined assortment**. **First**, an assortment is determined "based on information provided by the consumer, the **determined assortment** of feminine care products including a non-commercial quantity of at least one type of absorbent catamenial product." This is functional because the **determined assortment** and thus the outcome of this determination changes depending on the provided information. **Second**, a purchase order is accepted for the **determined assortment** of feminine care products. This is functional because this step of accepting does not apply to a purchase order for other than the **determined assortment** so that, once again, the outcome of accepting changes depending on the **determined assortment**. **Third**, the consumer is prompted "to place another purchase order for products corresponding to the **determined assortment** of feminine care products." Thus, the prompting depends on the **determined assortment** so that, once again, the outcome of prompting changes depending on the **determined assortment**.

Furthermore, Applicants note that the Examiner's position is contrary to MPEP 2106 because the **determined assortment** is not "descriptive material stored on or employed by a machine":

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described *supra* in paragraphs IV.B.1(a) and IV. B.1(b). Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (combining printed instructions and an old product into a kit will not render the claimed invention nonobvious even if the instructions detail a new use for the product).< Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material. **MPEP 2106 (VI), second paragraph.**

The examples given above include a computer-readable storage medium, descriptive material which does not alter machine function or descriptive material which does not alter how the process steps are performed. In contrast, Applicants do not claim a medium. Further, the **determined assortment** alters machine function because it controls what particular products are offered. Further, the **determined assortment** alters how the process is performed because, as pointed out above, the **determined assortment** affects the outcome of the method.

Looking more closely to MPEP 2106 and the distinction between functional and nonfunctional, Applicants note that the distinction is primarily applicable to data structures and computer programs, neither of which are recited by independent claim 1

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material *Per Se* or Computer Programs Representing Computer Listings *Per Se*

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, **computer programs** claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.

Since a **computer program** is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. See paragraph IV.B.2(a), below.

(b) Nonfunctional Descriptive Material

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multimedia material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process. **MPEP 2106 (IV) (B) (1) (a & b).**

In contrast to the MPEP definition of non-functional, the **determined assortment** limitation defines a functional interrelationship depending on user information and user action, not purely non-functional descriptive material as defined above. Further, the example highlighted above is applicable and on point. Because the **determined assortment** defines a particular grouping of products and upon recognizing that particular grouping, another defined process is implemented, the **determined assortment** defines a

functional interrelationship among the products and the processes performed when utilizing that product data, and as such is statutory because it implements a statutory process.

The Examiner also improperly cites *In re Lowry* which relates to a data structure to support the rejection:

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory)....
MPEP 2106 (IV) (B) (1) second paragraph.

In summary, the **determined assortment** limitation of claim 1 is functional, must be considered and distinguishes over the prior art so that claims 1-17 are patentable.

Independent claims 18, 45 and 57 also recite function limitations. In particular, claims 18 and 57 recite "an assortment" and claim 45 recites "one type ... and at least one additional product."

In the Response To Arguments, the Examiner also notes:
"Therefore, Hartman explicitly teaches prompting the consumer to place another order."

Applicants submit that the Examiner is reading into Hartman and that the Examiner is failing to give full weight to the claim recitals. Hartman suggests a "continue shopping" button, nothing more. Claim 1 recites "prompting the consumer to place (1) another purchase order (2) for products corresponding to the **determined assortment** of feminine care products" (numbering added for emphasis). In other words, claim 1 recites two aspects. The first aspect

is **another** purchase order meaning that this order is **in addition to** the previous order. Further, this is a prompting to place a **purchase order**, not to continue shopping, as taught by Hartman. The second aspect is that the prompting is specific to **corresponding products**. Thus, Hartman is deficient because the "continued shopping" button does not tie into corresponding products. Accordingly, the claims are patentable because the combined referenced are deficient. The rejection must be withdrawn.

There are additional reasons for patentability. As previously noted, claim 1 recites "accepting at the first location a purchase order placed by the consumer at the second location for at least the **determined assortment** of feminine care products" and "prompting the consumer to place **another purchase order for products corresponding to the determined assortment of feminine care products.**" Unlike Hartman, claim 1 recites that the consumer will be prompted to place an order for specific products, "products corresponding to the **determined assortment** of feminine care products". Hartman does not disclose prompting the consumer to place another, second purchase order for a **determined assortment** of products. In fact, Hartman is silent on the function of the "continue shopping" feature, as the reference character 108 does not appear in the specification of the patent. Thus, Hartman fails to address the problem solved by the invention and teaches away from the invention. Accordingly, claims 1 and the claims depending therefrom are patentable over these references and the rejection should be withdrawn.

The Examiner incorrectly argues that "One of ordinary skill in the art would have been motivated to do so [i.e.,

incorporate the teachings of Hartman into the method of Unger] in order.

With respect to claim 18, claim 18 recites "prompting the consumer periodically **as a function of the collected information and the accepted purchase order** to place **another** purchase order for products corresponding to the recommended assortment of feminine care products." Unger does not teach prompting the consumer to place **another** purchase order. Hartman does not teach that the prompting is a **function of the collected information and the accepted purchase order**. In fact, Hartman is silent on the function of the "continue shopping" feature, as the reference character 108 does not appear in the specification of the patent. Thus, Hartman fails to address the problem solved by the invention and teaches away from the invention. Accordingly, claim 18 and the claims depending therefrom are patentable over these references and the rejection should be withdrawn.

With respect to claim 45, claim 45 as amended recites "place a purchase order for a feminine care kit including at least one type of absorbent catamenial product and at least one additional product **including an ovulation test**." Unger and Hartman do not disclose placing an order for at least one additional product including **an ovulation test**. Thus, claim 45 and the claims depending therefrom are patentable over these references and the rejection should be withdrawn. Applicants fail to see the basis for this rejection. Applicants respectfully request the Examiner point to specific references to an ovulation test in Unger and Hartman or remove the rejection.

Claims 4 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable Unger in view of Hartman and further in view of Park. The Park reference is deficient for at least the same reasons as noted above with regard to Hartman and Unger. In particular, the Park reference fails to teach prompting the consumer to place **another** purchase order for products corresponding to the **determined assortment** of feminine care products. Thus, claims 1 and 18 and the claims depending therefrom are patentable over these references. Claims 4 and 22 depending from claims 1 and 18, respectively, are patentable for the same reasons as claims 1 and 18 so that this rejection should be withdrawn.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Unger in view of Hartman and further in view of Miller (5,947,302). Once again, claim 5 depends from claim 1 and is patentable for the same reasons as claim 1. In particular, the Miller patent fails to disclose or suggest prompting the consumer to place **another** purchase order for products corresponding to the **determined assortment** of feminine care products. Thus, claim 1 the claims depending therefrom are patentable over these references. Claim 5 depends from claim 1 and is patentable for the same reasons as claims 1 so that this rejection should be withdrawn.

Claims 9 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable Unger in view of Hartman and further in view of Isaacson (20020019778). The Isaacson reference is deficient for at least the same reasons as noted above with regard to Hartman and Unger. In particular, the Isaacson reference fails to teach prompting the consumer to

place **another** purchase order for products corresponding to the **determined assortment** of feminine care products. Thus, claims 1 and 18 and the claims depending therefrom are patentable over these references. Claims 9 and 29 depending from claims 1 and 18, respectively, are patentable for the same reasons as claims 1 and 18 so that this rejection should be withdrawn.

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Unger in view of Hartman and further in view of Swartz. Once again, claim 12 depends from claim 1 and is patentable for the same reasons as claim 1. In particular, the Swartz patent fails to disclose or suggest prompting the consumer to place **another** purchase order for products corresponding to the **determined assortment** of feminine care products. Thus, claim 1 the claims depending therefrom are patentable over these references. Claim 12 depends from claim 1 and is patentable for the same reasons as claims 1 so that this rejection should be withdrawn.

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Unger in view of Hartman and further in view of Swartz (5,947,302). Once again, claim 13 depends from claim 1 and is patentable for the same reasons as claim 1. In particular, the Miller patent fails to disclose or suggest prompting the consumer to place **another** purchase order for products corresponding to the **determined assortment** of feminine care products. Thus, claim 1 the claims depending therefrom are patentable over these references. Claim 13 depends from claim 1 and is patentable for the same reasons as claims 1 so that this rejection should be withdrawn.

Claims 16 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable Unger in view of Hartman and further in view of Official Notice "that it is old and well known in the art to periodically prompt a user to take an action." Applicants take exception to and traverse the Examiner's Official Notice and, in accordance with MPEP 2144.03C, request the Examiner cite a reference to support the Official Notice or remove the rejection. Further, it is noted that claim 16 recites "periodically prompting the consumer to place another purchase order for an assortment of feminine care products" and claim 18 recites "accepting a standing purchase order for the recommended assortment of feminine care products." Such recitals are much more than periodically prompting, as suggested by the Examiner. Applicants request the Examiner cite a reference which teaches such recitals or allow claims 16 and 28.

In any case, as explained above, claims 1 and 18 and the claims depending therefrom are patentable over these references. Claims 16 and 28 depending from claims 1 and 18, respectively, are patentable for the same reasons as claims 1 and 18 so that this rejection should be withdrawn.

Applicants note that none of the other art cited by the Examiner is relevant to the amended claims. Thus, it is submitted that all rejections should be withdrawn.

It is felt that a full and complete response has been made to the Office action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to telephone the undersigned.

Applicants do not believe that a fee is due in connection with this response. If, however, the Commissioner determines that a fee is due, he is authorized to charge Deposit Account No. 19-1345.

Respectfully submitted,

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